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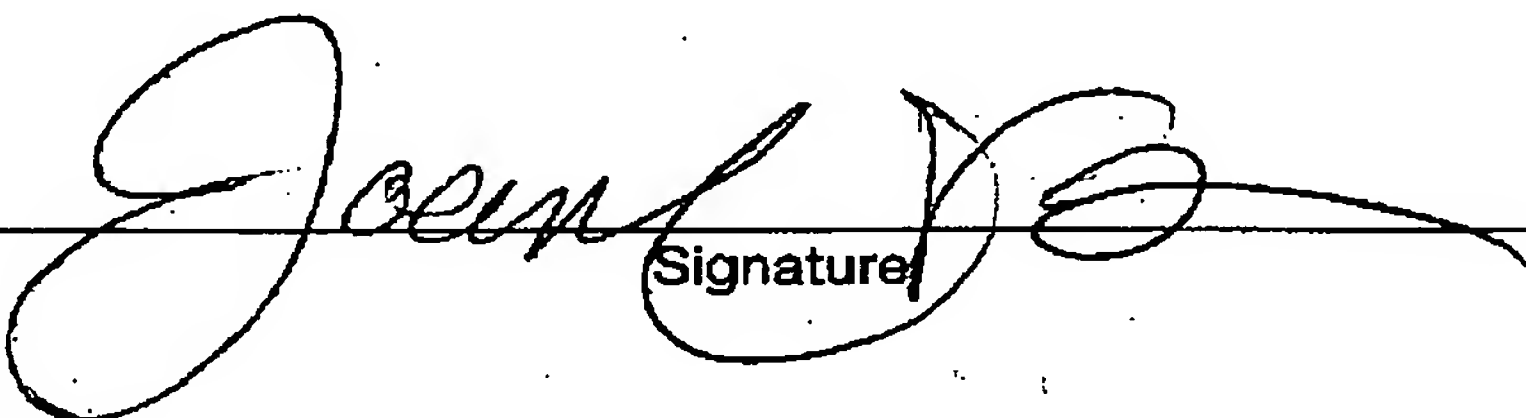
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Joanne Vos

Typed or printed name of person signing Certificate

U.S. Patent Application Serial No. 10/817,589

Title: Particle Based Electrodes and Methods of Making Same

Filing Date: April 2, 2004

Attorney Docket No. 356-157-USP

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MAIL STOP AMENDMENT

PTO Fax Number: 571-273-8300

FROM: Thomas J. Osborne, Jr

Reg. No. 39,796

Transmitted herewith are:

Fax Transmittal Cover Sheet (1 page); and

Petition Under 37 C.F.R. 1.144 (3 pages)

Total Pages in Transmission: 4

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## In Re the Application of:

Applicant	: Linda Zhong et al.	
Appln. No.	: 10/817,589	Confirmation No: 4922
Filed	: April 2, 2004	Group Art Unit: 2831
Title	: PARTICLE BASED ELECTRODES AND METHODS OF MAKING SAME	Examiner: Ha, Nguyen T
		Docket No. 356-157-USP

## PETITION UNDER 37 C.F.R. 1.144

## MAIL STOP TECHNOLOGY CENTER

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Applicant petitions the Director to review the Requirement for Restriction issued on 14 January 2008 and made final in the Office Action 8 May 2008.

In the Requirement for Restriction issued 14 January 2008, the Examiner alleged that the claims of the present application are directed to six patentably distinct species, and stated that "The species are independent or distinct because there is more than one species in the present application." Requirement for Restriction at page 2. The Examiner provided no reasoning or explanation for the arbitrary division of the claims into six allegedly patentably distinct species.

Applicant responded to the Requirement for Restriction on 31 January 2008 by provisionally electing embodiment I, including claims 1-21, with traverse. Applicant noted that MPEP §803 requires that "Examiners must provide reasons and/or examples to support conclusions...." Applicant also cited MPEP §809.02(a), which states that, where restriction between species is appropriate, the Examiner should "[p]rovide reasons why the species are independent or distinct."

Hensley Kim &amp; Holzer, LLC

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Attorney Docket No. 356-157-USP

In the Office Action mailed 8 May 2008, the Examiner made the Requirement for Restriction final, acknowledging Applicant's election of claims 1-21 with traverse. However, the Examiner stated that "The traversal is on the ground(s) that the searches for 1-21 and claims 22-52 would be co-extensive. This is not found persuasive because other claims would be classified in a different class than claims 1-21." Office Action at page 2.

Applicant respectfully submits that the Examiner has incorrectly stated Applicant's ground for traversal. Applicant's grounds for traversal are that the Examiner has merely provided a conclusion without the required supporting rationale. MPEP §808 requires that the Examiner articulate "(A) the reasons (as distinguished from the mere statement of conclusion) why each embodiment *as claimed* is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween...." MPEP §808.02 requires that the Examiner **MUST** show "by appropriate explanation" (A) separate classification thereof, (B) a separate status in the art when they are classifiable together, or (C) a different field of search.

In the Office Action mailed 8 May 2008, which made the Requirement for Restriction final, the Examiner has merely made the conclusory statement that "other claims would be classified in a different class than claims 1-21." Office Action at page 2. The Examiner has not provided any evidence that claims 22-52 would be classified in a different class than claims 1-21, nor has the Examiner provided suggested classifications for any of the six separate species identified in the Requirement for Restriction. The Examiner has also failed to provide any evidence that a different field of search would be required.

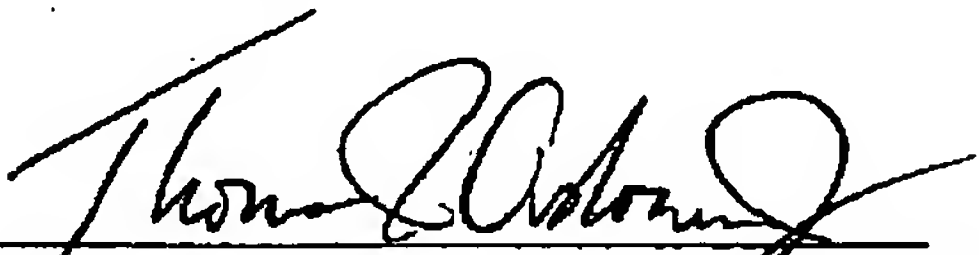
Applicant respectfully submits that the Examiner has failed to satisfy the burden established by MPEP §808.02. As the Examiner has provided no reasons for dividing among the embodiments enumerated in the Requirement for Restriction, Applicants respectfully submit that this Final Requirement for Restriction is improper. Reconsideration and withdrawal of this Requirement for Restriction are respectfully requested.

Applicant believes no fees or petitions are due with this filing. However, should any such fees or petitions be required, please consider this a request therefor and authorization to charge Deposit Account No. 50-3199 as necessary.

If the Examiner should require any additional information or believes any issues could be resolved via a telephone interview, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

June 24<sup>th</sup> 2008  
Date

  
Thomas J. Osborne, Jr. Reg. No. 39,796  
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